

REMARKS

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the remarks contained herein. Claims 1-18 are pending in this application.

Rejection under 35 U.S.C. § 103(a)

Claims 1-2, 6-10, and 13-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tal ('856).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

The Office Action admits that Tal does not specifically teach having a management unit that is operable to assign a protected region. The Office Action attempts to cure this deficiency by introducing common knowledge, whereby the Office Action states that the teaching of Tal implies sellers and buyers who have defaulted on payment terms, i.e. payments and non-payments. The motivation for making the combination was presented as follows:

“It would have obvious ... to modify the database of Tal by including a protected region of payments and non-payments because this would monitor a buyer who has paid a seller and the seller has failed to deliver the goods or services properly.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The provided motivation is nonsensical in view of the stated result. It is unclear how providing a protected region will monitor a buyer who has paid a seller and the seller has failed to deliver the goods or services properly. As such, the cited language is merely a statement that the reference can

be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a modification of Tal is desirable. Therefore, the rejection of claims 1-2, 6-10, and 13-18 should be withdrawn.

The Office Action admits that Tal does not specifically teach having a management unit that is operable to assign a protected region. The Office Action attempts to cure this deficiency by introducing common knowledge, whereby the Office Action states that the teaching of Tal implies sellers and buyers who have defaulted on payment terms, i.e. payments and non-payments. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a multi-application terminal comprising: a memory for storing a plurality of payment and non-payment applications, a memory management unit for separating said applications in said memory ... ,and a processor for executing one or more applications. Tal does not disclose at least these limitations. The abstract of Tal discloses maintaining a database of buyers and sellers. The database would be used to inform sellers when a buyer has defaulted or to inform buyers when a seller has defaulted. The database comprises data, not applications that can be executed by a processor. Nothing in Tal teaches or suggests having a plurality of payment and non-payment applications. The proposed modification to Tal does not provide such teachings. Thus, the modified Tal does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 8 defines a method for providing a plurality of services on a payment terminal, said method comprising: storing a plurality of payment and non-payment applications in separate memory locations within said terminal..., assigning a protected region within said memory to each application running on said terminal, and selecting at least one application to

be executed on said terminal by an operator. Applicants note that claim 8 is not specifically discussed in the Office Action. Nonetheless, Tal does not disclose at least these limitations. The abstract of Tal discloses maintaining a database of buyers and sellers. The database would be used to inform sellers when a buyer has defaulted or to inform buyers when a seller has defaulted. The database comprises data, not applications that can be executed by a processor. Nothing in Tal teaches or suggests having a plurality of payment and non-payment applications. The proposed modification to Tal does not provide such teachings. Thus, the modified Tal does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 8 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 15 defines a system for providing credit card verification at a point of sale, said system comprising: a terminal for accepting data from a credit card in conjunction with point of sale purchase information. Applicants note that claim 15 is not specifically discussed in the Office Action. Nonetheless, Tal does not disclose at least these limitations. The abstract of Tal discloses maintaining a database of buyers and sellers. The database would be used to inform sellers when a buyer has defaulted or to inform buyers when a seller has defaulted. Column 3, lines 32-35 of Tal discloses having “terminals that are dedicated to exchanging information with the service center.” Nothing in Tal teaches or suggests having a terminal for accepting data from a credit card in conjunction with point of sale purchase information. The proposed modification to Tal does not provide such teachings. Thus, the modified Tal does not teach the all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 15 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2, 6-7, 9-10, 13-14, 16-18 depend from base claims 1, 8, and 15, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2, 6-7, 9-10, 13-14, 16-18 sets forth features and limitations not recited by modified Tal. Thus, the Applicants respectfully asserts that for the above reasons claims 2, 6-7, 9-10, 13-14, 16-18 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103(a)

Claims 3-5 and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over modified Tal ('856) in view of Ishiguro et al. ('796, hereinafter Ishiguro).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

As discussed above with regards to claims 1 and 8, the provided motivation is insufficient for the proposed modification to Tal. The motivation provided to combine Ishiguro with modified Tal does not overcome the deficiency of motivation to modify Tal. Since claims 3-5 and 11-12 depend from claims 1 and 8, no valid suggestion has been made as to why a combination of modified Tal and Ishiguro is desirable. Therefore, the rejection of claims 3-5 and 11-12 should be withdrawn.

The Office Action admits that modified Tal does not specifically teach having a public key and authenticating application. The Office Action attempts to cure this deficiency by introducing Ishiguro, which the Office Action alleges to teach having such a limitation. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Base claim 1 is defined as described above. Modified Tal does not disclose these limitations, as discussed above. Ishiguro is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Base claim 8 is defined as described above. Modified Tal does not disclose these limitations, as discussed above. Ishiguro is not relied upon in the Office Action as disclosing

these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claims 3-5 and 11-12 depend from base claims 1 and 8, respectively, and thus inherit all limitations of their respective base claim. Each of claims 3-5 and 11-12 sets forth features and limitations not recited by the combination of modified Tal and Ishiguro. Thus, the Applicants respectfully asserts that for the above reasons claims 3-5 and 11-12 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

Claims 1, 3, 8-11, and 15 have been amended to clarify the inventions defined therein. These claims have not been amended to overcome a rejection or objection of record, nor have they been amended for the purpose of narrowing their scope in the face of prior art. No new matter has been entered.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10013451-1, from which the undersigned is authorized to draw.

Dated: March 22, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV255076199US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: March 22, 2004

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